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09/273,021	03/19/1999	HAROLD W. MILTON JR.	MILT.777	6459

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EXAMINER

FEILD, JOSEPH H

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/273,021

Applicant(s)

MILTON, HAROLD W.

Examiner

JOSEPH H FEILD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. This office action is responsive to Amendment B, filed 6/5/02. Please note that Grant Yang, formerly in charge of examining this application, is no longer employed at the USPTO. Joseph Feild is now in charge of this application. Please update future correspondence accordingly. In this office action, all references to specific line numbers in the claims are directed toward the "clean copy" of the claims in Amendment B, filed 6/5/02 (pages 2-12), except where noted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to adequately describe how a computer is able to "draft an independent claim" that "recites and isolates the patentable novelty" (as in claim 1 (lines 18-21) and claim 19 (lines 24-27)) or "drafting claims ultimately dependent upon . . . " (as in claim 1 (lines 22-23) and claim 19 (lines 28-29)). Further regarding claim 19, the specification fails to provide enablement for the subject matter recited in lines 55-56—"adding each reference numeral to every showing of the element in the drawings *in response to that element being assigned a reference numeral*".

The remaining dependent claims are rejected for fully incorporating the deficiencies of their respective base claim(s).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to independent claim 1:

Quotation marks should be used to enclose the subject matter encompassing lines 5-12;

The word "immediately" should be inserted after "storing a page break" at each of lines 13 and 14 to more clearly define the invention;

The word, "CLAIMS", at line 13 should be enclosed in quotes;

The phrase, "ABSTRACT OF THE DISCLOSURE", at line 14 should be enclosed in quotes;

With respect to lines 18-21, "reciting and isolating the patentable novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the characterized by clause" is vague and indefinite. First, it is unclear how a computer is able to "recite and isolate patentable novelty". If this step is performed by a user, then the claim should recite this. If it is

performed by a computer, then the claim should reflect this (refer to the rejection under 35 USC §112, 1st paragraph for the latter case);

At line 21, "characterized by" should be enclosed in quotation marks;

At lines 25-26, the phrase, "DESCRIPTION OF THE PREFERRED EMBODIMENT", should be enclosed in quotation marks.

Regarding dependent claim 2 (as originally filed), "—the—" should be enclosed in quotation marks.

Regarding dependent claims 3-18, refer to the discussion of claims 1-2 above regarding enclosing terms in quotation marks.

Regarding independent claim 19, refer to the discussion of claims 1-2 above.

Furthermore:

At lines 20-23, the element should be rewritten: "... stating, "It is to be understood that reference numerals in the claims are merely for convenience and are not to be in any way limiting", immediately before, the page break before the heading, "CLAIMS";

At lines 24-27, in addition to the vague and indefinite nature of "drafting an independent claim", as is discussed above with respect to claim 1, the phrase, "only to the extent necessary to support ..." is subjective and unsuitable for claim language because the metes and bounds are indeterminate;

At lines 46-54, "the element names" lacks antecedent basis, "the highest figure number" lacks antecedent basis;

At lines 57-62, "selecting and storing . . . abstract sentences . . . which most succinctly and specifically describe . . . " is subjective and unsuitable for claim language because the metes and bounds are indeterminate.

Regarding independent claim 20, refer to the discussion above with respect to claims 1-19.

Furthermore, at line 16, "the paragraph" should be replaced by "the text, " (note the comma);

At lines 17-25, the subject matter should be enclosed in quotation marks;

At line 27, "the following paragraphs" should be replaced by "the text";

At lines 28-37, the subject matter should be enclosed in quotation marks. Make sure the period is included within the quotation marks.

Note: Since there are so many errors in the claim language, applicant should also check for other errors.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-16, 18-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Newman, U.S. Patent No. 5,774,833, published Jun. 30, 1998 in view of Nehab, U.S. Patent No. 6,029,182, filed Oct. 4, 1996, published Feb. 22, 2000 and Manual of Patent Examining Procedure, 7th edition, published July 1998, herein known as MPEP.**

Regarding independent claim 1, Newman discloses the word processing program to store information about the patent, as on column 6, lines 20-22, and having a page break before the CLAIMS heading, as on column 8, lines 20-21, and having a page break before the ABSTRACT OF THE DISCLOSURE heading, as on column 8, lines 20-21, making sure that dependent claims have antecedent basis on its prior or independent claims, as **claim analysis results in the identification of what is known in the patent art as antecedent basis**, as on column 4, lines 27-32, and storing a duplicate set of dependent claims, as Newman's system load's the patent application one section at a time into memory to be processed, as on column 3, lines 16-20. However, Newman does not expressly disclose having a document template, footer with attorney identification, or the exact format of the headings.

However, Nehab discloses that a **predefined document templates exist**, and you can have **personalized templates either by editing existing templates or by creating new ones**, as on column 8, lines 11-15. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a document template to store the format. One of ordinary skill in the art would have been motivated

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to do this because it was notoriously well known in the art that templates provide an easy way to store a specific layout of a document.

Nehab also discloses that the outputted formats can have headers and footers, as on column 24, line 53. However, Nehab does not expressly disclose that the footer information will contain the information of the attorney file identification. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add footer information. One of ordinary skill in the art would have been motivated to do this because it is notoriously well known to put textual information that is repeated on every page to be placed in a footer.

Furthermore, the following guidelines, found in the MPEP under section 601, illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.**
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.**
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.**
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)**
- (e) BACKGROUND OF THE INVENTION.**
 - (1) Field of the Invention.**

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Furthermore, the attorney's or agent's full post office address and other contact information must be given in every power of attorney, MPEP 601.02. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the document template formatted to that of the MPEP. One of ordinary skill in the art would have been motivated to do this because document templates are essentially layouts that are pre-created, and a patent template would want to have the layout specified by patent law.

Regarding dependent claim 2, Newman discloses a **patent analyzer program that determines correction for the text and replacing the highlighted text**, as on column 6, lines 56-62. However, Newman does not expressly disclose replacing the word "said" with the word "the" to create a *grammatically correct sentence structure in the specification*; however, the MPEP discloses that the abstract may not have legal phraseology like "means" and said," as on MPEP 608.01(b).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to replace the words in the specification to be grammatically

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correct and to have a correct format. One of ordinary skill in the art would have been motivated to do this because a patent application should have the format and proper grammar as specified by patent law in the MPEP.

Regarding dependent claim 3, Newman does not expressly disclose a direct copying of the claim and the summary; however, Newman does disclose that the claims must have antecedent basis from the specification, as on column 13, lines 25-30. Furthermore, the replacement of "said" with "the" is rejected similarly above.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the independent claim in the SUMMARY OF THE INVENTION AND ADVANTAGES. One of ordinary skill in the art would have been motivated to do this because it would save much time, if the claims were written clearly, to simply use the independent claim, which is generally the broadest aspect of the invention, and have it rewritten in the specification.

Regarding dependent claims 4-7, Newman does not expressly disclose storing the first and second element names, searching for their occurrences, and selecting the numbers identifying the reference numerals and reference element names; however, Newman does disclose reading in the sections of the patent as disclosed above, and also teaches analysis to **verify that figures referenced agree with figures mentioned in the brief description section**, as on column 8, lines 57-60.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store the reference numbers and match them up with their respective element names. One of ordinary skill in the art would have been motivated

to do this because it is important when verifying figures and references that they have the same format required by patent law, which requires them to correctly match with element names and have proper antecedent basis.

Regarding dependent claim 8, Newman does not expressly disclose alternative phrasing of edit clauses of the duplicate set of claims; however, Newman does disclose the **patent analyzer program can replace highlighted text that needs correction**, as on column 6, lines 58-63.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to interspersing alternative phrasing of edited clauses of the claims. One of ordinary skill in the art would have been motivated to do this because a lot of the specification comes from the claims and vice versa, and if claims need correcting or editing then it would most likely need to correlate with the specification in order to not lack an antecedent basis.

Regarding dependent claim 9, Newman does not expressly disclose storing the abstract sentences retrieved from the heading ABSTRACT OF THE DISCLOSURE; however, Newman discloses that the patent analyzer has its own working memory to store information and analyze the text, as on column 6, lines 20-25.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store the information of the text; in particular, one would want to retrieve abstract sentences from under the heading ABSTRACT OF THE DISCLOSURE. One of ordinary skill in the art would have been motivated to do this because one would want to store the analyzing text to parse in a separate memory from

the actual word processor program in order to have ease of version management.

Furthermore, one would want to get abstract sentences from the ABSTRACT because by definition the sentences under the ABSTRACT heading are most likely sentences of the abstract.

Regarding dependent claim 10, Newman does not expressly disclose storing the reference numbers; however, as disclosed above Newman does disclose the patent analyzer program having its own memory and needing to store all the elements of the patent application, which includes the reference numbers imbedded in the specification and drawings. Furthermore, Newman does not expressly disclose adding parenthesis around the reference numbers; however, the MPEP 608.01 (m) states that **reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims.**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add parentheses to the reference numbers in the claims and abstract. One of ordinary skill in the art would have been motivated to do this because as stated before it would be better to place parentheses around reference numbers, and furthermore if the template is for a patent application one would want the layout to coincide with the patent laws as much as possible.

Regarding dependent claims 11-14 and 16, Newman does not expressly disclose drafting sentences for the Technical Field, Prior Art, Summary of the Invention, Related Applications, and the Brief Description of the Drawings. But as stated above, the specification requires having all these headings and is further explained in MPEP 601.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the headings and their respective descriptive statements underneath the headings. One of ordinary skill in the art would have been motivated to do this because in order to have an accurate template for patent applications, one would have wanted to properly conform to the current edition of the MPEP.

Regarding dependent claim 15, Newman discloses verifying and identifying the numbered figure elements in paragraphs of the detailed description, as on column 9, lines 1-4.

Regarding dependent claim 18, Newman does not expressly disclose adding a paragraph before the claims stating to the effect that the invention has *many modifications and variations*; however, it is notorious in the art to have a paragraph before the claims asserting that the invention is limited by the description described. Newman gives an example stating that **the present invention has been described above with reference to preferred embodiments. However, those skilled in the art will recognize that changes and modifications may be made in these preferred embodiments without departing from the scope of the present invention, as on column 14, lines 39-44.**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add a statement asserting variations of the invention are possible in light of the teachings. One of ordinary skill in the art would have been motivated to do this because it is notoriously well known in the art to include a statement specifying the variability of the invention in regards to the scope of the invention.

Regarding independent claims 19-20 are a method and a computer program and computer directed to the limitations of combined limitations of claims 1-18 and are similarly rejected as above.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Nehab and the MPEP as applied to claim 14 above, and further in view of Hunter, U.S. Patent No. 6,298,327, filed Mar. 8, 1995, published Oct. 2, 2001.

Regarding dependent claim 17, Newman does not expressly disclose always adding the statement *Other advantages of the present invention will be readily appreciated as the same becomes better understood by reference to the following detailed description when considered in connection with the accompanying drawings wherein: ...*; however, it was notoriously well known at the time of the invention by those of ordinary skill in the art to add a sentence similar to that as Hunter discloses **The features of the invention will be better understood by reference to the accompanying drawings which illustrate presently preferred embodiments of the invention, as on column 6, lines 30-35.**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add in a paragraph stating the advantages in the invention are better appreciated in the drawings. One of ordinary skill in the art would have been motivated to do this because it is notoriously well known to add these types of statements to clarify the patent application and in addition it is a common practice among patent applications to add a statement to that effect.

Response to Arguments

9. Applicant's arguments filed 6/5/02 have been fully considered but they are not persuasive.

Applicant argues that since Newman analyzes an existing patent, and does not create one, claim 1 distinguishes over Newman. However, the examiner points out that (1) the claim language is open-ended (use of the word "comprising"), and (2) the combination of the prior art would yield the claimed template that includes the claimed elements. Since Newman includes a word processor in conjunction with the analyzer, the examiner maintains that one of ordinary skill in the art would know to use Newman in combination with Nehab and the MPEP to "prepare patent applications" as set forth in the claims for the reasons given above under 35 USC §103. Furthermore, the claims have so many 35 USC §112, 2nd paragraph errors, that ~~the~~ the overall scope of the claims is impossible to determine. Another point is that since the claims are generally silent with regard to whether the computer is fully responsible for the claimed steps or partly responsible (i.e., the claims are completely silent with regard to user intervention). If the computer is fully responsible, then the 35 USC §112 1st paragraph problems with

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enablement further cloud the issues. The examiner, therefore, maintains that since Newman employs a word processor in conjunction with the analyzer, one of ordinary skill in the art would have known to perform standard editing operations to generate a new application based on the combined teachings of Newman, Nehab, the MPEP, and the general knowledge of persons having ordinary skill in the art. It is also noted that in Newman, if any errors are found and corrected as a result of analysis, effectively, a "new patent application" exists. Furthermore, Newman's invention could easily be used to generate a related application or continuing application. Applicant is urged to carefully review and amend the claim language in order to obviate the deficiencies outlined above.

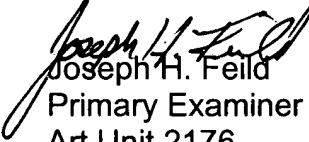
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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH H FEILD whose telephone number is (703) 305-9792. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HEATHER HERNDON, can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are:

(703) 746-7238	(After Final Communication)
(703) 746-7239	(Official Communication)
(703) 746-7240	(Status Inquiries, Draft Communication).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Joseph H. Feild
Primary Examiner
Art Unit 2176
August 22, 2002